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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/740,221	12/19/2000	Graham H. Thompson	SMB 2 0910	4476
7590 James W. McKee Fay, Sharpe, Beall, Fagan Minnich & McKee, LLP 1100 Superior Avenue, 7th Floor Cleveland, OH 44114-2518		EXAMINER CHOUDHURY, AZIZUL Q		
		ART UNIT 2145		
		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

09/740,221

Applicant(s)

THOMPSON ET AL.

Examiner

AZIZUL CHOUDHURY

Art Unit

2145

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/15/07.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 16-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 16-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

Detailed Action

This office action is in response to the correspondence received on November 15, 2007.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 14 and 29 fail to fall within a statutory category of invention. They are directed to the program itself, not a process occurring as a result of executing the program, a machine programmed to operate in accordance with the program nor a manufacture structurally and functionally interconnected with the program in a manner which enables the program to act as a computer component and realize its functionality. The claims are also clearly not directed to a composition of matter. Therefore, the claims are deemed non-statutory under 35 USC 101.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-14 and 16-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al (US Pat No: 5,761,420) in view of Hagiyuda (Foreign

Patent No: JP 10133984 A), hereafter referred to as Johnson and Hagyuuda, respectively.

1. With regards to claim 1, Johnson teaches through Hagyuuda, a collaborative computer telephony system, comprising: a communication network (Figure 2, element 48); a plurality of integrated computer telephony devices connected to the network and identified by unique IP addresses (Figure 2, element 40), at least two of said integrated computer telephony devices supporting collaboration application programs (column 1, lines 60-67, Johnson); an indicator on at least one of said integrated computer telephony devices (The screens of elements 46X and 46Y of Figure 2, Johnson); and a collaborate control program associated with each of said at least two integrated computer telephony devices for detecting commonly supported ones of said collaboration application programs and in response activating said indicator (Figure 2 and column 1, line 53 – column 2, line 46, Johnson).

However, Johnson does not describe the indication of compatible collaborative software in depth. In the same field of endeavor, Hagyuuda teaches how collaborative systems (see paragraph 1, Hagyuuda) displays an icon (equivalent to claimed indicator) when it is determined that software on both ends are compatible for the communication meeting (see p. 3, section "Means for Solution" Hagyuuda). Therefore, it would have been obvious to one skilled in the art, during the time of the invention, to have combined the teachings of Johnson

with those of Hagyuda, to enable common application capability checks in communication meeting designs (see p. 3, section "A Technical Problem" Hagyuda).

2. With regards to claim 2, Johnson teaches through Hagyuda the system further comprising a user input device on said at least one of said integrated computer telephony devices for launching said commonly supported ones of said collaboration application programs in the event said indicator is activated (Figure 2, elements 46X and 46Y have input devices, Johnson).
3. With regards to claim 3, Johnson teaches through Hagyuda the system wherein said network is a local area network (Figure 2, element 48, Johnson).
4. With regards to claim 4, Johnson teaches through Hagyuda the system wherein said network is the Internet (Figure 2, element 48, Johnson).
5. With regards to claim 5, Johnson teaches through Hagyuda the system wherein said collaboration application programs include video conferencing applications, fax applications, document sharing applications, and shared whiteboard applications (column 4, lines 25-26, Johnson).

6. With regards to claim 6, Johnson teaches through Hagyuuda the system wherein said integrated computer telephony devices each further comprise a telephone and a computer (Figure 2 illustrates both computers and telephones, Johnson).
7. With regards to claim 7, Johnson teaches through Hagyuuda the system wherein said computer and telephone are each connected directly to the network (Johnson's design allows for "double-session" where a connection exists for phones and a connection exists for computers (column 1, lines 53-60, Johnson)).
8. With regards to claim 8, Johnson teaches through Hagyuuda the system wherein said computer is connected to said telephone which in turn is connected directly to the network (Johnson's design allows for ROLM phones where a phone and computer are connected to one another and both share a single phone line (column 3, lines 47-60, Johnson)).
9. With regards to claim 9, Johnson teaches through Hagyuuda the system wherein said telephone is connected to said computer which in turn is connected directly to the network (Johnson's design allows for ROLM phones where a phone and computer are connected to one another and both share a single phone line (column 3, lines 47-60, Johnson)).

10. With regards to claim 10, Johnson teaches through Hagyuda the system wherein said indicator further comprises a light on said telephone and said user input device is a button on said telephone (While Johnson's design allows for buttons and indicators (GUI) on the computer (Figure 2, elements 46X and 46Y), Johnson does not disclose the use of indicators (lights) and buttons on telephones. "Official notice," is hereby taken that the use of lights and buttons on telephones is well known. Thus, the telephone design of Johnson's disclosure comprises lights and input buttons. Therefore it would have been obvious to one skilled in the art, during the time of the invention, to incorporate telephones with lights and buttons in order to provide a user with a user interface to the telephone).
11. With regards to claim 11, Johnson teaches through Hagyuda the system wherein said indicator and user input device further comprise a graphical user interface on said computer (Figure 2, elements 46X and 46Y, Johnson).
12. With regards to claim 12, Johnson teaches through Hagyuda a collaborative computer telephony system including a communication network, a plurality of telephones (Figure 2, element 40) and associated computer (Figure 2, elements 46X and 46Y) connected to the network (Figure 2, element 48) and identified by respective IP addresses (it is inherent that networked devices have IP addresses), at least two of said computers supporting collaboration application

programs (column 1, lines 60-67, Johnson), and an indicator on at least one of said telephones, a method for controlling said indicator comprising the steps of exchanging IP addresses of said at least two computers over said network; issuing a request from a first one of said computers to a second one of said computers for a list of said collaboration application programs supported by said second one of said computers; comparing said list with a further list of supported ones of said collaboration application programs within said first computer; and activating said indicator at said first telephone in the event of at least one commonly supported ones of said collaboration application in said first and second ones of said computers (Figure 2 and column 1, line 53 – column 2, line 46, Johnson. While Johnson's design allows for buttons and indicators (GUI) on the computer (Figure 2, elements 46X and 46Y), Johnson does not disclose the use of indicators (lights) and buttons on telephones. "Official notice," is hereby taken that the use of lights and buttons on telephones is well known. Thus, the telephone design of Johnson's disclosure comprises lights and input buttons. It would have been obvious to one skilled in the art, during the time of the invention, to incorporate telephones with lights and buttons in order to provide a user with a user interface to the telephone.

However, Johnson does not describe the indication of compatible collaborative software in depth. In the same field of endeavor, Hagyuda teaches how collaborative systems (see paragraph 1, Hagyuda) displays an icon (equivalent to claimed indicator) when it is determined that software on both ends

are compatible for the communication meeting (see p. 3, section "Means for Solution" Hagyuda). Therefore, it would have been obvious to one skilled in the art, during the time of the invention, to have combined the teachings of Johnson with those of Hagyuda, to enable common application capability checks in communication meeting designs (see p. 3, section "A Technical Problem" Hagyuda).

13. With regards to claim 13, Johnson teaches through Hagyuda, a computer telephony apparatus for use in a collaborative computer telephony system comprising a network and a plurality of terminals, said apparatus comprising: indicator means for indicating that a collaborative session is set up with another computer telephony apparatus (The screens of elements 46X and 46Y of Figure 2); and collaborative control means for detecting the presence of collaborative control means in said another computer telephony apparatus and for activating said indicator means in response (column 1, line 53 – column 2, line 46, Johnson).

However, Johnson does not describe the indication of compatible collaborative software in depth. In the same field of endeavor, Hagyuda teaches how collaborative systems (see paragraph 1, Hagyuda) displays an icon (equivalent to claimed indicator) when it is determined that software on both ends are compatible for the communication meeting (see p. 3, section "Means for Solution" Hagyuda). Therefore, it would have been obvious to one skilled in the

art, during the time of the invention, to have combined the teachings of Johnson with those of Hagyuda, to enable common application capability checks in communication meeting designs (see p. 3, section "A Technical Problem" Hagyuda).

14. With regards to claim 14, Johnson teaches through Hagyuda, a carrier medium carrying a computer program for controlling a computer to: receive a request for a collaborative session at least one second computer, issue a request to said at least one second computer over a network for a list of collaborative programs supported by said at least second computer, compare said list with a list of supported collaboration programs within said computer; and issuing an activation signal to activate an indicator in the event that at least one collaborative program is commonly supported by said computer and said at least one second computer (column 1, lines 60-67 and column 4, lines 25-26, Johnson).

However, Johnson does not describe the indication of compatible collaborative software in depth. In the same field of endeavor, Hagyuda teaches how collaborative systems (see paragraph 1, Hagyuda) displays an icon (equivalent to claimed indicator) when it is determined that software on both ends are compatible for the communication meeting (see p. 3, section "Means for Solution" Hagyuda). Therefore, it would have been obvious to one skilled in the art, during the time of the invention, to have combined the teachings of Johnson with those of Hagyuda, to enable common application capability checks in

communication meeting designs (see p. 3, section "A Technical Problem" Hagyuda).

15. With regards to claim 16, Johnson teaches through Hagyuda, a collaborative computer telephony system, comprising: a communication network (Figure 2, element 48); a plurality of integrated computer telephony devices connected to the network (Figure 2, elements 40, 46X and 46Y), at least two of said integrated computer telephony devices supporting collaboration application programs for implementing communication sessions therebetween (column 1, lines 60-67, Johnson); a user input device on at least one of said integrated computer telephony devices (Figure 2, elements 46X and 46Y feature keyboards); and a collaborate control program associated with each of said at least two integrated computer telephony devices for detecting commonly supported ones of said collaboration application programs and initiating said communication session in response to user activation of said user input device (column 1, line 53 – column 2, line 46, Johnson).

However, Johnson does not describe the indication of compatible collaborative software in depth. In the same field of endeavor, Hagyuda teaches how collaborative systems (see paragraph 1, Hagyuda) displays an icon (equivalent to claimed indicator) when it is determined that software on both ends are compatible for the communication meeting (see p. 3, section "Means for Solution" Hagyuda). Therefore, it would have been obvious to one skilled in the

art, during the time of the invention, to have combined the teachings of Johnson with those of Hagyuda, to enable common application capability checks in communication meeting designs (see p. 3, section "A Technical Problem" Hagyuda).

16. With regards to claim 17, Johnson teaches through Hagyuda the system further comprising an indicator on said at least one of said integrated computer telephony devices for indicating detection of said commonly supported ones of said collaboration application programs (The screens of elements 46X and 46Y of Figure 2).
17. With regards to claim 18, Johnson teaches through Hagyuda the system wherein said network is a local area network (Figure 2, element 48, Johnson).
18. With regards to claim 19, Johnson teaches through Hagyuda the system wherein said network is the internet (Figure 2, element 48, Johnson).
19. With regards to claim 20, Johnson teaches through Hagyuda the system wherein said collaboration application programs include video conferencing applications, fax application, document sharing applications, and shared whiteboard applications (column 4, lines 25-26, Johnson).

20. With regards to claim 21, Johnson teaches through Hagyuda the system wherein said integrated computer telephony devices each further comprise a telephone and a computer (Figure 2, elements 40, 46X and 46Y).
21. With regards to claim 22, Johnson teaches through Hagyuda the system wherein said computer and telephone are each connected directly to the network (Johnson's design allows for "double session" where a connection exists for phones and a connection exists for computers (column 1, lines 53-60, Johnson)).
22. With regards to claim 23, Johnson teaches through Hagyuda the system wherein said computer is connected to said telephone which in turn is connected directly to the network (Johnson's design allows for ROLM phones where a phone and computer are connected to one another and both share a single phone line (column 3, lines 47-60, Johnson)).
23. With regards to claim 24, Johnson teaches through Hagyuda system wherein said telephone is connected to said computer which in turn is connected directly to the network (Johnson's design allows for ROLM phones where a phone and computer are connected to one another and both share a single phone line (column 3, lines 47-60, Johnson)).

24. With regards to claim 25, Johnson teaches through Hagyuda the system wherein said indicator further comprises a light on said telephone and said user input device is a button on said telephone (While Johnson's design allows for buttons and indicators (GUI) on the computer (Figure 2, elements 46X and 46Y), Johnson does not disclose the use of indicators (lights) and buttons on telephones. "Official notice," is hereby taken that the use of lights and buttons on telephones is well known. Thus, the telephone design of Johnson's disclosure comprises lights and input buttons. Therefore it would have been obvious to one skilled in the art, during the time of the invention, to incorporate telephones with lights and buttons in order to provide a user with a user interface to the telephone).

25. With regards to claim 26, Johnson teaches through Hagyuda the system wherein said indicator and user input device further comprise a graphical user interface on said computer (Figure 2, elements 46X and 46Y).

26. With regards to claim 27, Johnson teaches through Hagyuda, in a collaborative computer telephony system including a communication network (Figure 2, element 48), a plurality of telephones and associated computers connected to the network and identified by respective IP addresses (Figure 2, elements 40, 46X and 46Y), at least two of said computers supporting collaboration application programs (column 1, lines 60-67, Johnson), and a user input device on at least

one of said telephones, a method comprising the steps of: detecting user activation of said user input device; exchanging IP addresses of said at least two computers over said network; issuing a request from a first one of said computers to a second one of said computers for a list of said collaboration application programs supported by said second one of said computers: comparing said list with a further list of supported ones of said collaboration application programs within said first computer; and initiating a communication session between said first and second ones of said computers in the event of at least one commonly supported collaboration application in said first and second ones of said computers (Column 1, line 53 – column 2, line 46, Johnson. While Johnson's design allows for buttons and indicators (GUI) on the computer (Figure 2, elements 46X and 46Y), Johnson does not disclose the use of input devices on telephones. "Official notice," is hereby taken that the use of buttons on telephones is well known. Thus, the telephone design of Johnson's disclosure comprises input buttons. Therefore it would have been obvious to one skilled in the art, during the time of the invention, to incorporate telephones input buttons in order to provide a user with a user interface to the telephone).

However, Johnson does not describe the indication of compatible collaborative software in depth. In the same field of endeavor, Hagyuda teaches how collaborative systems (see paragraph 1, Hagyuda) displays an icon (equivalent to claimed indicator) when it is determined that software on both ends are compatible for the communication meeting (see p. 3, section "Means for

Solution" Hagyuda). Therefore, it would have been obvious to one skilled in the art, during the time of the invention, to have combined the teachings of Johnson with those of Hagyuda, to enable common application capability checks in communication meeting designs (see p. 3, section "A Technical Problem" Hagyuda).

27. With regards to claim 28, Johnson teaches through Hagyuda, computer telephony apparatus for use in a collaborative computer telephony system having a communication network, said apparatus comprising: a user input for initiating a collaborative session with another computer telephony apparatus (Figure 2, elements 46X and 46Y); and collaborative control means for detecting the presence of collaborative controlled means in said another computer telephony apparatus in response to user activation of said user input (column 1, line 53 – column 2, line 46, Johnson).

However, Johnson does not describe the indication of compatible collaborative software in depth. In the same field of endeavor, Hagyuda teaches how collaborative systems (see paragraph 1, Hagyuda) displays an icon (equivalent to claimed indicator) when it is determined that software on both ends are compatible for the communication meeting (see p. 3, section "Means for Solution" Hagyuda). Therefore, it would have been obvious to one skilled in the art, during the time of the invention, to have combined the teachings of Johnson with those of Hagyuda, to enable common application capability checks in

communication meeting designs (see p. 3, section "A Technical Problem" Hagyuda).

28. With regards to claim 29, Johnson teaches through Hagyuda, a carrier medium carrying a computer program for controlling a computer to: receive a request for a collaborative session with at least one second computer; issue a request to set at least one second computer over a network for a list of collaborative programs supported by said at least one second computer; compare said list with a list of supported collaboration programs within said computer; and initiate said collaborative session in the event that at least one collaborative program is commonly supported by said computer and said at least one second computer (column 1, line 53 – column 2, line 46 and column 4, lines 25-26, Johnson).

However, Johnson does not describe the indication of compatible collaborative software in depth. In the same field of endeavor, Hagyuda teaches how collaborative systems (see paragraph 1, Hagyuda) displays an icon (equivalent to claimed indicator) when it is determined that software on both ends are compatible for the communication meeting (see p. 3, section "Means for Solution" Hagyuda). Therefore, it would have been obvious to one skilled in the art, during the time of the invention, to have combined the teachings of Johnson with those of Hagyuda, to enable common application capability checks in communication meeting designs (see p. 3, section "A Technical Problem" Hagyuda).

29. The obviousness motivation applied to claim 1 is applicable to claims 2-14 and 16-29.

Remarks

Applicant's arguments with respect to claims 1-14 and 16-29 have been considered but are moot in view of the new ground(s) of rejection.

In addition, the application remarks that the 101 rejection issued for claims 14 and 29 are improper because the claims are tangible. The applicant points out that the advisory action issued on 8/7/06 states that the claims had overcome the 101 rejection. The examiner agrees that the claims were deemed statutory during the time of the advisory action in 2006. While in 2006 it was deemed that such amendments were sufficient for overcoming the 101 rejection, it is current 101 policy, the claims continue to stand rejected because statutory claims cannot be directed to the program itself.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AZIZUL CHOUDHURY whose telephone number is (571)272-3909. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on (571) 272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. C./
Examiner, Art Unit 2145

/Jason D Cardone/
Supervisory Patent Examiner, Art Unit 2145